



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/764,560 | 12/12/1996 | JUN KAKUTA | 1083.1027/JD | 4899 |

21171 7590 11/27/2002

STAAS & HALSEY LLP
700 11TH STREET, NW
SUITE 500
WASHINGTON, DC 20001

EXAMINER

HUYNH, CONG LAC T

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2178

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/764,560

Applicant(s)

KAKUTA ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 9/23/02 for the application filed on 12/12/96.
2. Claims 1-27 are pending in the case. Claims 1, 17, 21, 25, 26, and 27 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole. It would have been obvious to one of ordinary skill in the art have been obvious to one of ordinary skill in the art have been obvious to one of ordinary skill in the art have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 (c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).
5. Claims 1-3, 17-18, 21-22, 25-27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima et al. (US Pat No. 5,659,791, 8/19/97) in view of Khoyi et

al. (US Pat No. 5,421,015) and Frank et al. (US Pat No. 5,651,107, 7/22/97, filed 8/16/94, priority 12/15/92).

With respect to independent claim 17, Nakajima discloses:

-- obtaining information from the external application program in accordance with the result of the analysis (col 2, lines 20-43; col 1, lines 46-61, the scrap object is integrated into a destination document or transferred between applications via a clipboard after the information is selected to be extracted from the document)

-- creating an information object in accordance with the obtained information and attribute information which includes object ID, object type and information type (col 6, lines 25-28, encapsulating of the selected information into an object is created automatically by the system to encapsulate the selected information in response to extracting and that is stored in the memory; col 5, lines 64-67, an object is a combination of data structure that hold *attribute data* and *functions that act upon the attribute data*; col 6, lines 64-67, giving a name for an object for *referencing the object*, which means each object must have an ID; col 5, lines 55-58, *recognizing of the information type to handle the reintegration of an object*)

It is noted that the "analyzing an event" step is inherently included in Nakajima since the obtaining step is performed in accordance with the result of the analysis.

Nakajima does not disclose the priority for showing of objects, time stamp, object link which are able to be modified after being created as an information object. Nakajima also does not disclose showing the information object such that the information object appears different from any non-selected information in the external program.

Khoyi discloses:

- the object catalog including the object table and link table (figure 5)
- the object table includes object identifiers, object type and object location (figure 6)
- the link table includes link ID, link type, parent object identifiers, child object identifiers (figure 7)
- the linking of data objects (col 3, lines 12-20; col 43, lines 1-11)
- the ability of editing of the moved or copied objects (col 43, lines 66-67; col 44, lines 1-5)
- the changing the manner of drawing the information object on the basis of the attribute information (col 3, lines 22-36)
- *a new object is created at will by a user by modifying the object prototype in the object prototype table to change the characteristics of the object (col 3, lines 37-48, when the characteristics of an object is changed, the appearance of the object should be changed. In other words, the appearance of the selected object is different from the non-selected object)*

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Khoyi into Nakajima to have the information objects, for user selecting of information, which include object ID, object type, object link and the ability of modifying objects after created. As disclosed, the attribute information includes object ID, object type and object link, parent object ID and child object ID which are object ID of next object, thus motivating the including of the priority for showing objects and time stamp, which are other information data related to the object.

In addition, the fact that Nakajima shows that the information is selected as requested, transferred and integrated into a document of another application implies that the system can analyze an event for selecting information as well as creating an information object as desired.

In addition, Nakajima and Khoyi do not disclose a ***transparent window*** through which contents of the information controlled by the external application program is seen.

Frank discloses a transparent window through which the content of the document beneath that window is seen (figure 7, the transparent window overlays the mail list document window and the content of the mail list document is seen through the transparent window).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Frank to include the information controlled by the external application to the content of the document in the window beneath the transparent window since in Frank the application in the window beneath the transparent window is *different* from the application in the transparent window. This motivates that the application of the window beneath the transparent window can be an external one.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Frank into Nakajima and Khoyi to provide a transparency mechanism to present information, and easily view and edit information such that a user can see through a window to view and manipulate underlying data that would normally obscured.

In addition, Frank does not explicitly disclose that said transparent window having a position and size being a same position and a same size as said window.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Frank to include the features that both the transparent window and the window have the same sizes and have the same position since it was well known that one can adjust the size of a window and can move a window to a desired position. This suggests making the two windows having the same sizes and the same positions.

With respect to claim 18, which is dependent on claim 17, Nakajima does not explicitly disclose returning the content of the selected information object to the original external application program from which the information object has been obtained or a specified external application program which is different from the original external application program.

Instead Nakajima discloses that the information is selected to be extracted from the document and transferred to a clipboard provided in the operating system using the scrap object. The selected information then is transferred from the clipboard to an application (col 1, lines 55-62). Nakajima also discloses that after the scrap object is created, it may be subsequently integrated into a document, including the document from which it originated (col 4, lines 53-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nakajima to include the returning feature above to Nakajima because Nakajima provides the clipboard for transferring selected

information between applications which include the original application and the application different from the original application.

Claim 21 is for a computer readable program code to perform the steps in claim 17, and is rejected under the same rationale.

Claims 2 and 3 are the system for performing the step in claim 18, and is rejected under the same rationale.

Claim 22 is the program code means for performing the step in claim 18, and is rejected under the same rationale.

With respect to independent claim 1, Nakajima discloses, as in claim 17:

-- storing contents and attribute information of an information object to be shown, the attribute information being concerned with showing the information object and including object ID, object type, information type (col 6, lines 25-28, the selected information is created automatically by the system in response to extracting and these objects are stored in the memory; col 5, lines 64-67, an object is a combination of data structure that hold attribute data and functions that act upon the attribute data; col 6, lines 64-67, giving a name for an object for referencing the object which means each object must have an ID; col 5, lines 55-58, recognizing of the information type to handle the reintegration of an object)

-- drawing information object on said transparent window in accordance with the content and attribute information relating to the display of the object stored in said information storing unit, and changing a manner of drawing the information object on the basis of

the attribute information (col 3, lines 37-48, modifying objects by changing the objects' characteristics)

-- performing at least any one of processes including a process of controlling said information storing unit, a process of controlling said message transmitting unit and a process of controlling said drawing unit, in accordance with the result of the analysis reported from said event analyzing unit (col 2, lines 20-43; col 1, lines 46-61; col 3, lines 25-35; (the information is selected, transferred and integrated into another document using a scrap object as a vehicle for interapplication transfer of information))

-- transmitting a control message to an external application program in order to get a selected information in the external application program (col 2, lines 20-43; col 1, lines 46-61; col 3, lines 25-35; transmitting messages is inherently included in the performing step, otherwise information selection, transferring, or integrating can not be performed)

-- analyzing all the events from an operation system and reporting a result of the analysis (col 2, lines 55-60, operating system provides code for a clipboard and code for implementing a user interface; col 3, lines 25-40, role of the mouse and the operating system in the drag-and-drop mechanism used to create a scrap object in which the movement of the mouse, the depression and the release of the mouse button, each constitutes an event that is translated by the operating system into a message, and the operating system post most of the mouse messages into a message queue for a currently executing application program; reporting a result of the analysis is inherently included in the performed step since the performing step is carried out in accordance with the result of the analysis)

Nakajima does not disclose the priority for showing of objects, time stamp, object link which are able to be modified after being created as an information object. Nakajima

also does not disclose showing the information object such that the information object appears different from any non-selected information in the external program.

Khoyi discloses:

- the object catalog including the object table and link table (figure 5)
- the object table includes object identifiers, object type and object location (figure 6)
- the link table includes link ID, link type, parent object identifiers, child object identifiers (figure 7)
- the linking of data objects (col 3, lines 12-20; col 43, lines 1-11)
- the ability of editing of the moved or copied objects (col 43, lines 66-67; col 44, lines 1-5)
- the changing the manner of drawing the information object on the basis of the attribute information (col 3, lines 22-36)
- *a new object is created at will by a user by modifying the object prototype in the object prototype table to change the characteristics of the object (col 3, lines 37-48, when the characteristics of an object is changed, the appearance of the object should be changed. In other words, the appearance of the selected object is different from the non-selected object)*

Nakajima and Khoyi do not disclose displaying on a window displaying information controlled by an external application program, a transparent window through which contents of the information controlled by the external application program is seen.

Frank discloses a transparent window through which the content of the document beneath that window is seen (figure 7, the transparent window overlays the mail list document window and the content of the mail list document is seen through the transparent window).

Art Unit: 2178

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Frank to include the information controlled by the external application to the content of the document in the window beneath the transparent window since in Frank the application in the window beneath the transparent window is *different* from the application in the transparent window. This motivates that the application of the window beneath the transparent window can be an external one. Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Frank into Nakajima and Khoyi to provide a transparency mechanism to present information, and easily view and edit information such that a user can see through a window to view and manipulate underlying data that would normally obscured.

In addition, Frank does not explicitly disclose that said transparent window having a position and size being a same position and a same size as said window.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Frank to include the features that both the transparent window and the window have the same sizes and have the same position since it was well known that one can adjust the size of a window and can move a window to a desired position. This suggests making the two windows having the same sizes and the same positions.

Independent claim 25 includes part of limitations of claims 1, and is rejected under the same rationale.

Independent claim 26 is for the computer-readable program code for the method claim 25, and is rejected under the same rationale.

Independent claim 27 includes limitations disclosed in claim 1, and therefore is rejected under the same rationale.

6. Claims 4-12, 16, 19-20, 23-24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima in view of Khoyi and Frank as applied to claim 17 above, and further in view of Person (*Using Windows 3.1*, 1993).

With respect to claim 19, which is dependent on claim 17, Nakajima, Khoyi, and Frank do not disclose the editing of the contents of the selected information objects after created.

Person discloses the editing the contents of the embedded objects in a document (p.235, 236, 521, 522).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have incorporated Person to Nakajima because Nakajima shows the transferring selected information objects and Person shows the editing the selected information objected after created.

With respect to claim 20, which is dependent on claim 17, Nakajima shows the combining objects when a scrap object integrated into another object of other

document. Nakajima also discloses the class object that refers to a group of objects thus all scrap objects belong to the scrap object class have the same type of attributes and functions (col 3, lines 1-12). Nakajima does not show the editing process including moving objects, deleting objects, changing objects and creating objects.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have included moving, deleting, changing and creating objects since it was well known that a user can (a) move an object from one location to another by using the drag-and-drop mechanism, (b) delete an object by highlighting the object and pressing the delete key, (c) change an object by highlighting a portion of the object and pressing the delete key to remove that portion, (d) to create a new information object by selecting a portion of an object and save it under a different name.

Claim 23 is a computer program code means to perform the functions of claim 19, and is rejected under the same rationale.

Claim 24 is a computer program code means to perform the functions of claim 20, and is rejected under the same rationale.

Claims 4-10 are for the means included in the system to perform the functions disclosed in claim 20, and is rejected under the same rationale.

With respect to claim 11, which is dependent on claim 10, it was well known when a selected text or graphics is moved, the rest of the document is moved to maintain the relative location in the document.

With respect to claim 12, which is dependent on claim 10, the fact that a file subdirectory containing a plurality of files including the index file, if the index files is selected and deleted, the whole subdirectory is deleted, can be applied to the object group as claimed.

With respect to claim 16, which is dependent on claim 10, Nakajima does not disclose that an information object belonging to any one of information object groups and an information object which does not belong to any information object group are shown on the window by different ways. Person discloses the document including the information selected from different applications. The display of the whole document is different from the display of only the information from Microsoft Excel which are the graph and the table (page 208). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Person into Nakajima because Person shows the display of the combined document, including text and graphics, which is different from the document from Excel which includes only the graph and table.

7. Claims 13-15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima in view of Khoyi, Frank and Person as applied to claim 10 above, and further in view of Microsoft (*Microsoft Windows User's Guide*, 1992).

With respect to claim 13, which is dependent on claim 10, Nakajima, Khoyi and Person do not disclose the relationship of an information object in the information object group, when selected, is canceled.

Microsoft discloses that when deleting a link from an Cardfile object embedded in a Write document, both the link to the drawing and the drawing are removed from the document (p. 502).

With respect to claims 14 and 15, Nakajima, Khoyi, Person and Microsoft do not disclose that when the two objects are selected and the hierarchical relationship is given to the selected information objects to form the information object group, and when one of them is deleted, the other is removed, too.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified to include in Nakajima, Khoyi, Person and Microsoft said forming the information object group based on the selected objects and their given hierarchical relationship and said deleting feature since it was well known that if two selected objects has a hierarchical relationship, when one is deleted, the other is removed, too due to the inheritance.

Response to Arguments

8. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue that Frank fails to teach or suggest the transparent window changing position or size with the window.

Examiner agrees.

Frank does not explicitly disclose that said transparent window having a position and size being a same position and a same size as said window.

Art Unit: 2178

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Frank to include the features of changing both the transparent window and the window so that they can have the same sizes and the same position since it was well known that one can adjust the size of a window and can move a window to a desired position. This suggests making the two windows having the same sizes and the same positions.

Applicants argue that the combination of Nakajima, Khoyi and Frank is improper since Nakajima and Khoyi do not disclose overlapping the information objects and the external application program. Therefore, there is no motivation to use a transparent window in Frank to combine with Nakajima and Khoyi.

Examiner disagrees.

Nakajima discloses obtaining data objects from an external application (col 1, lines 46-61; col 2, lines 43) and Khoyi discloses modifying a data object by changing the characteristics of the object (col 3, lines 37-48).

Since Nakajima and Khoyi provides data objects from an external application and modifying a data object by changing the characteristics of the object, Nakajima and Khoyi suggest changing an object so that the object looks different by displaying the modified characteristics of the object on the transparent window in Frank and displaying the object on the window underlying. Therefore, the motivation of combining Nakajima, Khoyi, and Frank is proper.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

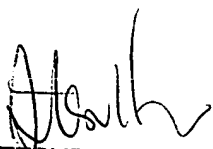
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 707-746-7238 for After Final communications.

Art Unit: 2178

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

clh
November 20, 2002



STEPHEN S. HONG
PRIMARY EXAMINER